

## **TABLE OF CONTENTS**

<b>I. REAL PARTY IN INTEREST .....</b>	<b>1</b>
<b>II. RELATED APPEALS AND INTERFERENCES .....</b>	<b>2</b>
<b>III. STATUS OF CLAIMS .....</b>	<b>2</b>
<b>IV. STATUS OF AMENDMENTS .....</b>	<b>2</b>
<b>V. SUMMARY OF CLAIMED SUBJECT MATTER .....</b>	<b>2</b>
<b>VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL .....</b>	<b>4</b>
<b>VII. ARGUMENT .....</b>	<b>5</b>
<b>VIII. CLAIMS APPENDIX.....</b>	<b>23</b>
<b>IX. EVIDENCE APPENDIX.....</b>	<b>29</b>
<b>X. RELATED PROCEEDINGS APPENDIX.....</b>	<b>30</b>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Imaddin ALBAZZ, et al.	:	Confirmation Number: 3924
	:	
Application No.: 09/972,403	:	Group Art Unit: 3689
	:	
Filed: October 5, 2001	:	Examiner: H. Riviere
	:	
For: SYSTEM AND METHOD FOR WORKFLOW CONTROL OF CONTRACTUAL ACTIVITIES		

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 13, 2008, in response to the Examiner reopening prosecution in the Office Action dated June 19, 2008, and in response to the Examiner reopening prosecution in the Office Action dated August 17, 2009, wherein Appellants appeal from the Examiner's rejection of claims 9-11, 13-19, 21-24, 33-35, and 37-40.

**I. REAL PARTY IN INTEREST**

This application is assigned to IBM Corporation by assignment recorded on October 5, 2001, at Reel 012242, Frame 0776.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellants are unaware of any related appeals and interferences.

## **III. STATUS OF CLAIMS**

Claims 9-11, 13-19, 21-24, 33-35, and 37-40 are pending and five-times rejected in this Application. Claims 1-8, 12, 20, 25-32, and 36 have been cancelled. It is from the multiple rejections of claims 9-11, 13-19, 21-24, 33-35, and 37-40 that this Appeal is taken.

## **IV. STATUS OF AMENDMENTS**

The claims have not been amended subsequent to the imposition of the Fifth Office Action dated March 2, 2010 (hereinafter the Fifth Office Action).

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

1 Referring to independent claim 9, a method of workflow control of contractual activities  
2 under a contract comprising a predefined set of terms and conditions is disclosed. Referring to  
3 Fig. 10, the contract terms and conditions are stored, information is received, and the terms and  
4 conditions of the contract are referenced to process the information and generate user interfaces  
5 in response (page 22, line 20 through page 23, line 2). The user interface is communicated to a  
6 contracting party (page 22, line 20 through page 23, line 2). Referring to Figures 3 and 9, the  
7 contract is generated by as follows. At least one compilation of business rules comprising a  
8 plurality of rules available to be selected for inclusion in the contract is stored (page 13, lines 8-  
9 17). At least one terms and conditions set containing parameters corresponding to selected rules  
10 from the compilation of business rules are stored (page 17, lines 9-19). Links are generated

1 between the compilation of business rules and the terms and conditions set to generate specific  
2 terms and conditions to be embodied in the contract (page 21, lines 1-5). The compilation of  
3 business rules, the terms and conditions set and the links are interlocked to lock the contract  
4 (page 21, lines 6-10; page 25, lines 1-7).

5 Referring to independent claim 17, a computer program product for use with a computer,  
6 the computer program product comprising a computer usable medium having computer readable  
7 program code embodied in said medium for workflow control of contractual activities under a  
8 contract comprising a predefined set of terms and conditions is disclosed. Referring to Fig. 10,  
9 the contract terms and conditions are stored, information is received, and the terms and  
10 conditions of the contract are referenced to process the information and generate user interfaces  
11 in response (page 22, line 20 through page 23, line 2). The user interfaces is communicated to a  
12 contracting party (page 22, line 20 through page 23, line 2). Referring to Figures 3 and 9, the  
13 contract is generated by as follows. At least one compilation of business rules comprising a  
14 plurality of rules available to be selected for inclusion in the contract is stored (page 13, lines 8-  
15 17). At least one terms and conditions set containing parameters corresponding to selected rules  
16 from the compilation of business rules are stored (page 17, lines 9-19). Links are generated  
17 between the compilation of business rules and the terms and conditions set to generate specific  
18 terms and conditions to be embodied in the contract (page 21, lines 1-5). The compilation of  
19 business rules, the terms and conditions set and the links are interlocked to lock the contract  
20 (page 21, lines 6-10; page 25, lines 1-7).

21 Referring to independent claim 33, a program product for use with a computer having  
22 computer readable program code for workflow control of contractual activities under a contract  
23 comprising a predefined set of terms and conditions is disclosed. Referring to Fig. 10, the

contract terms and conditions are stored, information is received, and the terms and conditions of the contract are referenced to process the information and generate user interfaces in response (page 22, line 20 through page 23, line 2). The user interfaces is communicated to a contracting party (page 22, line 20 through page 23, line 2). Referring to Figures 3 and 9, the contract is generated by as follows. At least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract is stored (page 13, lines 8-17). At least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules are stored (page 17, lines 9-19). Links are generated between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract (page 21, lines 1-5). The compilation of business rules, the terms and conditions set and the links are interlocked to lock the contract (page 21, lines 6-10; page 25, lines 1-7).

#### **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 9-11 and 13-16 were rejected under 35 U.S.C. § 101;
2. Claims 9-11 and 13-16 were rejected under the second paragraph of 35 U.S.C. § 112;
3. Claims 9-11, 13-19, 21-24, 33-35, and 37-40 were rejected under the Judicially Created Doctrine of Obviousness-type Double Patenting as being Unpatentable over Claims 9-14, 16, 21-24, and 33-35 of Copending U.S. Application No. 09/827,431 (hereinafter the '431 Application) and Claims 1-3, 5-8, 10-13, and 15-18 of Copending U.S. Application No. 09/972,434 (hereinafter the '434 Application);
4. Claims 9-11, 13-19, 21-24, 33-35, and 37-40 were rejected under 35 U.S.C. § 103 for obviousness based upon Conklin et al., U.S. Patent No. 6,338,050 (hereinafter Conklin), in view of Shirley et al., U.S. Patent No. 5,692,206 (hereinafter Shirley).

## **VII. ARGUMENT**

As is evident from Appellants' previously-presented comments during prosecution of the present Application and from Appellants' comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(c) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's Answer, the Examiner is required to include the aforementioned section in the Examiner's Answer.

### **THE REJECTION OF CLAIMS 9-11, 13-19, 21-24, 33-35, AND 37-40 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER THE '431 APPLICATION AND THE '434 APPLICATION**

For convenience of the Honorable Board in addressing the rejections, claims 10-11, 13-19, 21-24, 33-35, and 37-40 stand or fall together with independent claim 9.

With regard to Nonstatutory Double Patenting rejections, M.P.E.P. § 804(II)(B)(1) states

that

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.

The Examiner's statement of the rejection, however, evidences a complete lack of these factual inquiries in the Examiner's analysis. Instead, the Examiner alleges that both claims share certain limitations and asserts that "[t]hey all have a plurality of tiers, product list filters, elements that can be unilaterally filtered and product list filters." Simply identifying a few common limitations without explaining why the remaining limitations are obvious does not make a proper obviousness rejection.

Since (i) the Examiner has not established that these Graham factual inquiries were part of the Examiner's analysis; (ii) the Examiner has not identified the specific limitations recited in the present claims that are not allegedly disclosed by the claims of the '431 Application or by the

claims of the '434 Application; and (iii) the Examiner has not set forth an articulated reasoning with some rational underpinning to support the legal conclusion that these specific limitations are obvious in view of the claims of the '431 Application or in view of the claims of the '434 Application, Appellants respectfully submit that the Examiner has failed to establish a proper rejection of obviousness-type double patenting.

The above-reproduced arguments (incorporated herein) were previously presented on pages 8-10 of the Fourth Response dated November 17, 2009 (hereinafter the Fourth Response). The Examiner's response to these arguments is found in the fourth enumerated paragraph on page 3 and is reproduced below:

The Double patenting rejection is not withdrawn. Applicant's argument in regards to the product list filters remains unclear as the claims discussed are never noted.

The Examiner's response is non-responsive.

The Examiner has failed to establish a prima facie case of obviousness as to all of the claims. Since the Examiner has failed to set forth a prima facie case of obviousness, the Examiner's rejection of the claims cannot stand.

**THE REJECTION OF CLAIMS 9-11 AND 13-16 UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112**

For convenience of the Honorable Board in addressing the rejections, claims 10-11 and 13-16 stand or fall together with independent claim 9.



Regarding the Examiner's rejection of claims 9-11 and 13-16, the Examiner asserted the following on page 7 of the Fourth Office Action:<sup>1</sup>

For example claim 9 states "communicating a user interface". How is an interface communicated? And the limitation taken as a whole reads "communicating a user interface to a contracting party, wherein the contract is generated by". Did Applicant mean to confer that instead of contract the "contracting party" is generated? Or instead of contract the "user interface" is generated?

Appellants respectfully submit that the phrase "communicating a user interface" is not vague or indefinite. In this regard, if the Examiner went onto the internet and entered a website having a particular interface, prior to the Examiner 'entering the website,' a user interface would have been communicated, from the server hosting the website, to the Examiner's computer.

The Examiner's confusion of the phrase "communicating a user interface to a contracting party, wherein the contract is generated by" reflects the Examiner failure to recognize that a comma "," separates the two clauses within this phrase. As such, these clauses are to be read independently. Therefore, as claimed, the contract is generated (and not the contracting party).

The above-reproduced arguments (incorporated herein) were previously presented on pages 10 and 11 of the Fourth Response. The Examiner's response to these arguments is found in the fifth enumerated paragraph on page 3 and is reproduced below:

The 35 USC 112 paragraph 2 rejection of the pending claims is not withdrawn. Applicant's argument that "communicating a user interface" is not vague and specific by noting "if Examiner went onto the Internet and entered a website having a particular interface, prior to the Examiner 'entering the website,' a user interface would have been communicated" remains vague. Please note the discussion in paragraph 2 above. As a result, the rejection is not withdrawn.

Appellants respectfully submit that the Examiner's confusion reflects a failure to properly construe the language of the claims. The issue of claim construction is discussed in M.P.E.P. §

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<sup>1</sup> See all last full paragraph on page 5 of the Fifth Office Action.

2111, entitled "Claim Construction; Broadest Reasonable Interpretation," a portion of which is reproduced below:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) ... The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

As noted therein, claims are to interpreted in a manner consistent with the interpretation that those skilled in the art would reach. As would be recognized by those skilled in the art, a "user interface" is a programmatic functional structure. Moreover, to communicate a programmatic functional structure involves sending the programmatic functional structure (generically referred to by the Patent Office as functional descriptive material), usually over a computer network, from one entity to another entity (e.g., the contracting party). For example, for a user of an iPhone or similar device, such as an Android, the downloading of an application (which is includes a user interface) involves the "communicating a user interface to a ... party." This is a well-known, ubiquitous operation, the meaning of which is not indefinite, as alleged by the Examiner.

**THE REJECTION OF CLAIMS 9-11 AND 13-16 UNDER 35 U.S.C. § 101**

For convenience of the Honorable Board in addressing the rejections, claims 10-11 and 13-16 stand or fall together with independent claim 9.

Regarding claim 9 the Examiner asserted the following:

Here, applicant's method steps, fail the first prong of the Bilski decision since they are not tied to another statutory class and can be preformed [sic] without the use of a particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed [sic] within the human mind.

Notably absent from the Examiner's analysis is a claim construction as to the actual limitations being claimed. "[C]laim construction ... is an important first step in a § 101 analysis." In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc). Many of the claimed limitations are performed by a machine, and thus, claim 1 is tied to a particular machine. The Examiner's assertions that the steps "can be [performed] without the use of a particular apparatus" or "may be [performed] within the human mind" is completely without factual basis.

As discussed above with regard to the rejection under the second paragraph of 35 U.S.C. § 112, the communicating of a user interface requires the use of a machine since not all machines are capable of communicating user interfaces. Also, the generation of user interfaces requires the use of a particular machine since not all machines are capable of generating user interfaces. Applicants are entirely unclear how a user interface can be both generated and communicated "within the human mind." An interface is a "place at which independent and often unrelated systems meet and act on or communicate with each other."<sup>2</sup> The Examiner has failed to identify the alleged independent systems within the human mind that the Examiner's interface provides a place to meet and act on or communicate with each other.

The Examiner's response to these arguments is found in the second enumerated paragraph on page 2 of the Fifth Office Action and is reproduced below:

First of all, since "not all machines are capable of communicating user interfaces" it is dependent of Applicant to clearly state within the claims whether a machine is used and if so which. In claim 9, for example, step (a.) is unclear because it seems consists of the positively claimed sub-steps of storing, receiving and referencing. The generation of a user interface is never claimed as it is noted that the generation of this interface is merely referenced once the information is received. It is also unclear whether the step of storing is a first step or second step. As a result, when the user interface is communicated to a contracting party in step (b.) the communicating is interpreted as not being performed by a machine.

---

<sup>2</sup> <http://www.merriam-webster.com/dictionary/interface>.

1  
2           The Examiner requires that "Applicant to clearly state within the claims whether a  
3 machine is used and if so which." Appellants are unaware of any case law that requires such  
4 claim language. As such, the Examiner's requirement is legally unfounded.

5  
6           The Examiner asserts that "the communicating is interpreted as not being performed by a  
7 machine." The Examiner, however, provides no evidence to support such an interpretation. The  
8 fact that the Examiner can present an interpretation does not mean such an interpretation is  
9 reasonable. As earlier noted, user interfaces are programmatic functional structures. These  
10 programmatic functional structures, when employed as a user interface, are not amenable to be  
11 communicated without the use of a machine since it is through the use of machine that these user  
12 interfaces are both communicated and presented to a user.

13  
14           **THE REJECTION OF CLAIMS 9-11, 13-19, 21-24, 33-35, AND 37-40 UNDER 35 U.S.C. §**  
15 **103 FOR OBVIOUSNESS BASED UPON CONKLIN IN VIEW OF SHIRLEY**

16           For convenience of the Honorable Board in addressing the rejections, claims 10-11, 16-  
17 19, 24, 33-35, and 40 stand or fall together with independent claim 9; claims 21 and 37 stand or  
18 fall together with dependent claim 13; claims 22 and 38 stand or fall together with dependent  
19 claim 14; and claims 23 and 39 stand or fall together with dependent claim 15.

20  
21           On October 10, 2007, the Patent Office issued the "Examination Guidelines for  
22 Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR  
23 International Co. v. Teleflex Inc.," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination

Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on page 12 of the Fourth Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. Appellants, therefore, request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines for Determining Obviousness, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have

known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

#### Conklin

On page 10 of the Fourth Office Action,<sup>3</sup> the Examiner asserted the following as to the teachings of Conklin:

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract, storing at least one from the compilation of business rules, generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract., (Conklin: col. 21 -

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<sup>3</sup> See also the paragraph spanning pages 10 and 11 of the Fifth Office Action.

1 relational structuring of database; col.23 - storing of negotiations and results data; detailed rules  
2 for ordering).

3  
4 The Examiner's analysis is entirely deficient. Conklin does not disclose the claimed "at least one  
5 compilation of business rules comprising a plurality of rules available to be selected for inclusion  
6 in the contract" or "at least one terms and conditions set containing parameters corresponding to  
7 selected rules from the compilation of business rules." The claimed invention refers to (i) a  
8 "compilation of business rules;" (ii) "business rules comprising a plurality of rules available to be  
9 selected for inclusion in the contract;" (iii) "at least one terms and condition set;" (iv) "selected  
10 rules;" and (v) the "conditions set containing parameters corresponding to selected rules from the  
11 compilation of business rules."

12  
13 The Examiner's analysis refers to generic "negotiations and results data; detailed rules for  
14 ordering." At the outset, the "detailed rules for ordering" are not available to be selected for  
15 inclusion in the contract. Instead, Conklin teaches that "a sponsor 06 will usually want to  
16 establish more detailed rules for the ordering and processing of proposals." Thus, the rules are  
17 not intended to be placed into the proposal, but instead, the rules are for processing the proposal.  
18 Thus, the Examiner has mischaracterized the scope and content of Conklin.

19  
20 Regarding the "negotiations and results data," although Conklin teaches that this  
21 information is stored, the Examiner has failed to put forth any reasoned analysis that establishes  
22 that the stored of the "negotiations and results data" corresponds to limitation (i) through (v)  
23 discussed above. Thus, the Examiner has failed to present an accurate characterization of the  
24 scope and content of Conklin.



The above-reproduced arguments (incorporated herein) were previously presented on pages 16 and 17 of the Fourth Response. The Examiner's response to these arguments is found in the sixth enumerated paragraph on page 3 of the Fifth Office Action and is reproduced below:

The 35 USC 103 (a) rejection of the pending claims is not withdrawn. Applicant focuses arguments on the Conklin reference. Applicant argues that Conklin does not teach the compilation of business rules or at least one terms and conditions. However, Conklin in Fig. 16 shows that the terms selections are presented via an Internet interface and furthermore the selection of terms and conditions are presented in Figs. 1h; 1i; 11a-1 and 11a-2. As a result, the rejections are not withdrawn.

At the outset, Appellants note that the Examiner's "response" is non-responsive as to most of Appellants' arguments.

The Examiner asserts that "Applicant argues that Conklin does not teach the compilation of business rules or at least one terms and conditions." This is a misrepresentation of Appellants' arguments. Instead, Appellants argued that Conklin does not disclose the claimed "at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract" or "at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules." As such, what Appellants have argued that Conklin fails to teach is considerably more than the sparse few limitations identified by the Examiner.

Turning to the Examiner's cryptic citation of "Figs. 1h; 1i;<sup>4</sup> 11a-1 and 11a-2" of Conklin," Fig. 1h of Conklin in discussed in column 18, lines 23-37, which is reproduced below:

FIG. 1h illustrates the use of commonly available videoconferencing equipment such as a camera positioned at the top of a monitor connected to a simple desktop computer. With existing videoconferencing products, an image 11 of a participant at another site is displayed on the monitor at the same time the Web browser interface W1 to multivariate negotiations engine system 02 displays a list of the terms being negotiated. Those skilled in the art appreciate that

---

<sup>4</sup> The Examiner's analysis is unclear as to whether or not the Examiner is referring to Fig. 1i or Fig. 11L, as those figures are identified by Conklin.

1 most existing videoconferencing products also include voice communications as well. Thus, the  
2 negotiating participants can see and hear each other and the complex, multiple variables they are  
3 negotiating at the same time. Multivariate negotiations engine system 02 can archive the  
4 multimedia sessions as video and audio files to be stored with the text. (emphasis added)  
5

6 Although Fig. 1h teaches displaying "a list of the terms being negotiated," these teachings do not  
7 correspond to limitations (i) through (v) identified above. Moreover, the Examiner has not  
8 presented any analysis that further explains why the Examiner believes the limitations at issue  
9 are taught by Conklin.

10  
11 Fig. 1i of Conklin is discussed in column 23, line 37 through column 24, line 57. These  
12 teachings referred to the process flow illustrated in Fig. 1i. As discussed therein, a participant  
13 may propose "terms" to another participant. As further discussed, "terms could be formatted in  
14 any of a number of ways, such as pre-formatted forms, open field boxes, text areas, and so on."  
15 Thus, the Examiner has established that Conklin teaches the use of "terms."

16  
17 As claimed the "at least one terms and conditions set [contains] parameters corresponding  
18 to selected rules from the compilation of business rules." Notably absent from the Examiner's  
19 cited passages or the Examiner's analysis is an teaching/explanation as to terms and condition set  
20 "containing parameters corresponding to selected rules from the compilation of business rules,"  
21 as claimed. Thus, although Fig. 1i of Conklin may have established that Conklin teaches the use  
22 "terms," Conklin still fails to teach the remaining limitations at issue.

23  
24 Finally, Figs. 11a-1, 11a-2, is described by Conklin in column 16, lines 32-33 as "a  
25 completed letter of credit negotiated using the present invention." Appellants have unable to find  
26 any other discussion of these Figures with Conklin. Since the claimed invention is directed to

what happens before a contract has been finalized (e.g., "a completed letter of credit"), the Examiner's cited Figures do not appear to be relevant to the claimed limitations at issue.

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As to the claimed "interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract," the Examiner asserted the following on page 11 of the Fourth Office Action:

and interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract (Conklin: cols. 19 and 21 and col. 22, lines 1-40 — authoring process integrated with databases; relational structuring of databases; "databases 225 created according to the present invention use a combination of record, filed, relational names and delimiters to interrelate the elements within; Data is kept secure with firewalls and SSL encryptions; col. 20, lines 45-65 — "the present invention protects the documents with separate user names, passwords and access levels for each inquirer"; col. 21, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled."; col. 24, lines 15-60 - final document is noted as complete);

Appellants are entirely unclear how these alleged findings of fact have anything to do with the claimed limitations at issue. None of these features correspond to the claimed interlocking. As such, the Examiner has again failed to properly characterize the scope and content of Conklin.

The Examiner did not directly address these arguments in the Fifth Office Action within the "Response to Arguments" section. However, Appellants do note that on page 8 of the Fifth Office Action, the Examiner included the following language of "Fig. 1j – rules built based on community" to the above-reproduced paragraph. This additional citation, however, does not cure the previously-noted deficiencies of Conklin.

The following analysis is from the Second Appeal Brief, yet informative with regard to the language at issue. For ease of reference, the particular limitations at issue are "interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract" (emphasis added). Reference is made to paragraph [0095] of Appellants' specification,<sup>5</sup> which is reproduced below:

When final revisions of all contract elements are approved by negotiating parties, all elements are interlocked by the seller contract administration staff to prevent further changes to the contract, as shown in FIG. 8. The contract is locked, for example using conventional digital signature techniques or otherwise, to lock all contract elements including the designated Ts&Cs Set and the Product List Filter, and is registered by the seller's administrator as a signed contract. Thereafter, the Static Elements of the contract may be amended only by mutual agreement between the parties, in the manner illustrated in FIG. 9. (emphasis added)

Referring both to the claim language at issue and to paragraph [0095], the interlocking acts to "lock the contract," which prevents further changes to the contract. In this regard, reference is made to the following dictionary<sup>6</sup> definitions:

*intransitive verb*  
: to become locked together or interconnected  
*transitive verb*  
1 : to lock together : UNITE  
2 : to connect so that the motion or operation of any part is constrained by another.

Based upon these dictionary definition; the claimed phrase, *as a whole*; and with Appellants' specification, Appellants' position is that one having ordinary skill in the art would not interpret "interlocking" to merely mean "joined," as once alleged by the Examiner. Instead, one having ordinary skill in the art would have read the term "interlocking" in conjunction with the phrase "to lock the contract." Moreover, comparable to when two objects become interlocked so that one prevents movement of the other, the interlocking of the compilation of business rules, the terms and conditions set and the link locks this compilation of contract elements to prevent movement (i.e., changes) to the compilation of contract elements.

<sup>5</sup> Paragraph [0095] also corresponds to lines 1-7 on page 25 of Appellants' disclosure.

<sup>6</sup> <http://www.merriam-webster.com/dictionary/interlock>.

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Claim 13

With regard to dependent claim 13, the Examiner asserted the following in the last full paragraph on page 11 of the Fifth Office Action:

Conklin discloses storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products (Conklin col. 21, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled."; relational names and delimiters to interrelate the elements within).

Although the Examiner alleges that Conklin teaches the claimed "generating links between the product list filter, the terms and conditions set and the master list of products," the Examiner did not cite to any passages with Conklin that discloses these limitations. Moreover, the Examiner's analysis is silent as to these limitations. Thus, the Examiner has failed to properly characterize the scope and content of Conklin.

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Claim 14

With regard to dependent claim 14, the Examiner asserted the following in the first full paragraph on page 12 of the Fifth Office Action

Conklin discloses the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products (Conklin Fig 1g, item 70, "Search & Evaluate").

Appellants respectfully disagree.

Entirely absent from Fig. 1g is any mention that a product list filter *comprises a plurality*

of tiers and that each tier generates a list of a different subset of products. Instead, block 70 is described by Conklin as "search and evaluate processes 70, which enable a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings." Thus, the Examiner has further failed to properly characterize the scope and content of Conklin.

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Claim 15

With regard to dependent claim 15, the Examiner asserted the following in the first full paragraph on page 12 of the Fifth Office Action

Conklin discloses the contract comprises dynamic elements which can be unilaterally altered by a contracting party (Conklin col. 23, lines 37-53, "participant proposing terms to another participant on an initiating terminal (or desktop computer or workstation, etc.) over the Internet through multivariate negotiations engine system, thereby creating a communications path which is ultimately directed by multivariate negotiations engine system over the Internet to the destination terminal at which the selected other participant is active.").

Appellants respectfully disagree.

What has been cited by the Examiner is a bilateral altering of an element (i.e., both the "participant" and the "another participant" act to propose/alter a term. Thus, the Examiner has further failed to properly characterize the scope and content of Conklin.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections.

Application No.: 09/972,403

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 2, 2010

Respectfully submitted,

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CUSTOMER NUMBER 46320

**VIII. CLAIMS APPENDIX**

9. A method of workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, comprising the steps of:

a. storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate user interfaces in response, and

b. communicating a user interface to a contracting party, wherein  
the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules  
available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding  
to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and  
conditions set to generate specific terms and conditions to be embodied in the contract,  
and

interlocking the compilation of business rules, the terms and conditions set and  
the links to lock the contract.

10. The method as defined in claim 9 in which the user interface displays selected  
information based on terms and conditions in the contract.



11. The method as defined in claim 9 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

13. The method as defined in claim 9 including the further steps of storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products.

14. The method as defined in claim 13 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

15. The method as defined in claim 13 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

16. The method as defined in claim 15 in which the product list filter is a dynamic element.

17. A computer program product for use with a computer, the computer program product comprising a computer usable medium having computer readable program code embodied in said medium for workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, said computer program product having

a. computer readable program code for storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate user interfaces in response, and

b. computer readable program code for communicating the user interfaces to a contracting party, wherein

the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

18. The computer program product as defined in claim 17 in which the user interface displays selected information based on terms and conditions in the contract.

19. The computer program product as defined in claim 17 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

21. The computer program product as defined in claim 17 including the further steps of storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products.

22. The computer program product as defined in claim 21 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

23. The computer program product as defined in claim 21 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

24. The computer program product as defined in claim 23 in which the product list filter is a dynamic element.

33. A program product for use with a computer having computer readable program code for workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, the program product comprising:

- a. computer readable program code for storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate a user interfaces in response, and

- b. computer readable program code for communicating the user interfaces to a contracting party, wherein

the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

34. The program product as defined in claim 33 in which the user interface displays selected information based on terms and conditions in the contract.

35. The program product as defined in claim 33 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

37. The program product as defined in claim 33 including at least one product list filter, computer readable program code for generating a list of a specified subset of products from a master list of products, and computer readable program code for generating links between the product list filter, the terms and conditions set and the master list of products.

38. The program product as defined in claim 37 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

39. The program product as defined in claim 37 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

40. The program product as defined in claim 39 in which the product list filter is a dynamic element.

**IX. EVIDENCE APPENDIX**

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

**X. RELATED PROCEEDINGS APPENDIX**

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.